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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,097	03/11/2004	Fredrik Nilsson	12578/46202	6060

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KENYON & KENYON LLP  
ONE BROADWAY  
NEW YORK, NY 10004

EXAMINER
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STEELE, AMBER D

ART UNIT	PAPER NUMBER
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1639

MAIL DATE	DELIVERY MODE
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05/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/798,097

Applicant(s)

NILSSON, FREDRIK

Examiner

Amber D. Steele

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 102(e) Minden et al.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: none.  
Claim(s) objected to: none.  
Claim(s) rejected: 1-11, 13, 14, 17, 18, 21 and 24-27.  
Claim(s) withdrawn from consideration: 12, 15, 16 and 20.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☒ Other: please refer to the attached Advisory Action Continued.

  
MARK L. SHIBUYA  
PRIMARY EXAMINER

**Advisory Action Continued**

1. The amendment filed April 16, 2007 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance.

***Withdrawn Rejection***

2. The rejection of claims 1-11, 13-14, 17-18, 21, 25, and 27 under 35 U.S.C. 102(e) as being anticipated by Minden et al. WO 02/086081 A2 (filing date April 22, 2002) is withdrawn in view of applicant's arguments regarding that the determination of mass and the determination of abundance are two separate characterizing steps.

***Response to Arguments Regarding Maintained Rejection***

3. Applicant's argument directed to the rejection under 35 USC 103(a) as being unpatentable over Minden et al. WO 02/086081 A2 (filing date April 22, 2002) and Barry et al. WO 0225287 (filed September 19, 2001) for claims 1-11, 13-14, 17-18, 21, and 24-27 was considered but was not persuasive.

4. Applicant contends that Minden et al. does not "suggest that quantification of proteins in the array-bound heterogenous classes is desirable, much less possible".

Applicant states that Minden et al. is prior art which teaches "methods for protein sample analysis that suggested that heterogeneity (i.e. incomplete separation) could be tolerated following the separation of a sample on an array" (please refer to page 8, last paragraph of response received on April 16, 2007).

Applicant contends that Barry et al. only teaches a method of proteomic analysis wherein each binding reagent corresponds to one protein, requires advanced knowledge

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of proteins in the sample in order to generate an appropriate array of binders, and determination of abundance wherein the analysis is applied to homogenous classes of array-bound proteins. Applicant states that Barry et al. is prior art which teaches “determination of protein abundance in a sample...that rely on homogenous classes at each location on an array” (please refer to page 8, first full paragraph of the response received on April 16, 2007).

In conclusion, applicant contends that one of skill in the art reading both Minden et al. and Barry et al. would only be motivated to form homogenous classes of proteins as set forth by Barry et al. before determining the abundance of proteins in each homogenous class.

5. Applicant’s argument is not convincing since the combined teachings of Minden et al. and Barry et al. do render the method of the instant claims *prima facie* obvious.

In response to applicant's argument that there is no suggestion to combine the references taught by Minden et al., the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Barry et al. was utilized in the rejection for motivation which is reiterated along with the reasonable expectation of success statement: (1) one having ordinary skill in the art would have been motivated to do this because Barry et al. teach that the use of mass

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spectrometry and MALDI-TOF provide semi-quantitative and quantitative results for protein microarrays (please refer to page 1, lines 20-26 and 34-37; page 2, lines 1-24; page 3, lines 5-30; Examples 2-3) and (2) one of ordinary skill in the art would have had a reasonable expectation of success in the modification of the method of identifying proteins taught by Minden et al. with the MALDI-TOF analysis taught by Barry et al. because of the examples provided by Barry et al. showing that trypsin digested antibody arrays can be quantitated via MALDI-TOF (please refer to Examples 2-3).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

#### ***Future Communications***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amber D. Steele whose telephone number is 571-272-5538. The examiner can normally be reached on Monday through Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Schultz can be reached at 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ADS

May 8, 2007



MARK L. SHIBUYA  
PRIMARY EXAMINER